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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM F. CRISMORE, NIGEL A. SURRIDGE, DANIEL R. McMINN, RICHARD J. BODENSTEINER, ERIC R. DIEBOLD, R. DALE DELK, DAVID W. BURKE, JIAXIONG JASON HO, ROBERT KITCHEL EARL, and BRIAN A HEALD,

Appellants.

Appeal 2010-009990
Application 10/692,031
Technology Center 1700

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON APPEAL

This reissue application is a reissue divisional of application no. 10/008,788 (“the ‘788 application”), which is a reissue application of patent no. 5,997,817. Originally issued claims 1-32, as well as added claims 39-67 were presented in the ‘788 application. (See Amendment in ‘788 Application entered April 21, 2003.) Following a restriction requirement between an

electrochemical test device recited in claims 1-32 and a capillary test device recited in claims 39-67 (Office Action in the ‘788 Application entered August 11, 2003, p. 2), Appellants filed the instant reissue divisional application with claims 39-67. (*See* Preliminary Amendment filed in the instant application on October 23, 2003, p. 8). Subsequently, claims 1-67 were cancelled and claims 68-104 were filed. (Supplemental Response to Office Action Response filed April 19, 2007.) We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

The electrochemical test strip recited in Appellants’ independent claims 68, 82, and 96 each include a “fill line,” which is described in claims 68 and 96 as “extending across the capillary channel at a location intermediate the length of the capillary channel at a position such that movement of the blood sample to the fill line indicates sufficient filling of the test strip for conducting a test.”¹ (App. Br. 68, Claims App’x.) Claim 82 recites a “fill line” that extends across a “viewing area,” instead of the “capillary channel,” but is otherwise the same as that recited in claims 68 and 96. (App. Br. 71-72, Claims App’x.) This difference is not significant to the reasoning of our decision.

The Examiner rejected Appellants’ claims 68-104 under 35 U.S.C. § 112, first paragraph, as lacking written description support, and under 35

¹ Appellants’ claim 82 recites a “fill line” that extends across a “viewing area,” instead of the “capillary channel,” but is otherwise the same as that recited in claims 68 and 96. This difference is not significant to the reasoning of our decision.

U.S.C. § 251 as adding new matter to a reissue application², because he found the specification does not support a “fill line” that determines the addition of the proper amount of sample. (Ans. 4.) Whether a claim is supported by a sufficient written description is a finding of fact to be analyzed from the perspective of those of skill in the art. *See Regents Univ. Calif. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997).

Appellants point to several excerpts of their specification to support a “fill line.” (App. Br. 22-23.) For example, their specification states:

"The second new feature is a transparent or translucent window which operates as a "fill to here" line, thereby identifying when enough test sample (a liquid sample, such as blood) has been added to the test chamber to accurately perform a test. The window defines the minimum sample amount, or dose, required to accurately perform a test, and, therefore, represents a visual failsafe which reduces the chances of erroneous test results due to underdosing of a test strip.

(Spec., col. 1, l. 61, through col. 2, l. 4 (emphasis added).) According to the Examiner, the excerpts noted by Appellants do not teach or suggest that an *actual* line is placed on the device, but provide only that the window *can operate* as a line. (Ans. 5.)

The Examiner has not explained why, giving the claims their broadest reasonable construction, *see In re Am. Acad. Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (“During examination, ‘claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be

² The Examiner withdrew rejections under 35 U.S.C. § 102 and the doctrine of obviousness-type double-patenting in light of arguments made by Appellants in their Appeal Brief. (Ans. 2 and 4.)

interpreted by one of ordinary skill in the art.””), an actual line, rather than the transparent or translucent window which operates as a “fill to here” line, is required.

However, even were an actual line required, we note Figures 2 and 4 of Appellants’ specification, which are reproduced below.

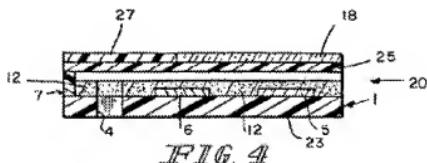
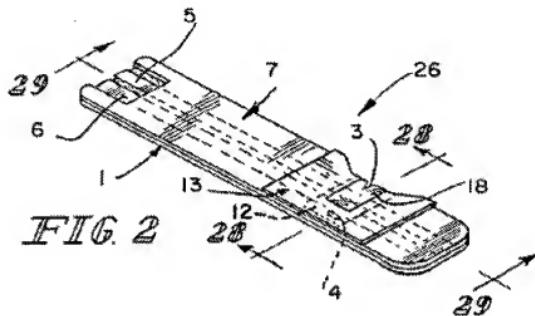


Figure 2 depicts a test strip, while Figure 4 depicts a cross-section of the test strip through line 28-28. (Spec., col. 2, ll. 49-54.) The test strip includes a transparent or translucent window (18) over roof (13) (Spec., col. 4, ll. 36-37), which allows the user to identify when enough sample has been added to the test chamber (*id. col. 1, ll. 63-67*) through sample application port (20) (*id. col. 8, ll. 61-63*). We are persuaded by Appellants’ argument that the

intersection of window (18) and pattern (27) (which is printed on roof 13 (*see* Spec. col. 8, ll. 26-29)) forms a “fill line” which extends across the capillary channel and indicates sufficient filling of the test strip, as claimed. (App. Br. 10.) The Examiner has not provided sufficient explanation why those of skill in the art would not consider this to be an actual line.

ORDER

Upon consideration of the record and for the reasons given, the rejection of claims 68-104 under 35 U.S.C. § 112, first paragraph, for lack of a written description, and under 35 U.S.C. § 251, for the addition of new matter to a reissue application, are REVERSED.

REVERSED

KMF